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| 09/827,698      | 04/06/2001  | Jeffrey Fischer      | P00043601X          | 5065             |

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EXAMINER

CARTER, MONICA SMITH

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3722

DATE MAILED: 08/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,698

Applicant(s)

FISCHER, JEFFREY *on*

Examiner

Monica S. Carter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22, 24, 28, 30-32, 34, 36 and 38-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 24, 28, 30-32, 34, 36 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 22, 24, 28, 30-32, 34, 36 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pasfield ('084).

Pasfield discloses a color-coded identification system comprising one or more rings (1, 2, 3) having one or more colors (see col. 2, lines 10-13), the rings provide information about the wearer of the ring (e.g., "providing an instantaneous alert to a "specific" care condition", see col. 5-8); one or more symbols (1', 2', 3') being integrated on the rings, and a chart (as seen in figure 3) having a color section (colored flags or discs 10-13), a keyword section and description section (the sections including a list of various conditions, such as, allergies, dietary requirements, etc. – see col. 2, lines 60-66 - Keyword – "Pressure- Sore Sensitive" and Description – "(PATIENT REQUIRES FREQUENT TURNING OR MOVEMENT)") that are associated with the colors (as seen in figure 3); whereby the individual wearing the ring can signal to an individual (e.g., doctors, nurses, attendants and staff members) via the rings an instant alert warning affecting the wearer of the ring.

Regarding the colors on the rings indicating a social interest, personality characteristic, or social trait of the individuals or a particular social interest, personality

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characteristic, or social trait of the of the first individual, or a particular social interest, personality characteristic, or social trait of the first individual desires in the second individual or vice versa, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Pasfield is capable of performing the intended use as claimed.

Regarding the rings providing information to each individual to determine if each individual is interested in initiating a social relationship with the other individual, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Pasfield is capable of performing the intended use as claimed.

Regarding the symbols indicating to the individuals that the rings provide information to social interests, personality characteristics, or social traits about the other

individual, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Pasfield is capable of performing the intended use as claimed.

Regarding the list of keywords describing the social characteristic and trait of an individual and the description section having a description of the social characteristic and trait of the individual, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required indicia on the chart, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of chart does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

It is noted that the “whereby clause” set forth in the claim (“whereby each individual can signal....to enter a social relationship”), merely states the result of the limitations in the claim and adds nothing to the patentability or substance of the claim. Furthermore, the wearer of the ring signals to other individuals care conditions in a quick, universal manner, since Pasfield discloses the colors of the system being in the form of language that is recognized universally by all races and dialects (see col. 2, lines 52-58).

Regarding claim 24, Pasfield discloses the ring being integrated with geometric shapes/dots (1', 2', 3' – circular flags).

Regarding claim 28, the ring being incorporated into an ornament sets forth the intended use of the ring. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, the ring of Pasfield is capable of performing the intended use of being incorporated into an ornament.

Regarding claim 30, Pasfield discloses the identification system using preselected colors, wherein the preselected colors are also provided in the chart (see col. 2, lines 59-68 through col. 3, lines 1-3). It is noted that the “whereby clause” set forth in the claim (“whereby one or more colors can indicate...in the second individual”),

merely states the result of the limitations in the claim and adds nothing to the patentability or substance of the claim.

Regarding claim 31, the identification system of Pasfield uses various colors (which would, inherently, include yellow, red, green, blue, purple, pale blue, gray, white, orange and black) in the color section of the chart ("Colored flags or discs - see col. 2, lines 65-66). Pasfield discloses the claimed invention except for the specific arrangement and/or content of indicia (e.g., "the color yellow being associated with a keyword "available", the keyword "available" having a description to indicate that the wearer is not dating anyone seriously or is interested in meeting others") set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required indicia for the chart, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of chart does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 32, the method of using the rings is disclosed in the above rejections to claims 22, 30 and 31, since the method discloses using the claimed system.

Regarding claim 34, see the above rejections to claim 24.

Regarding claim 36, the ring is capable of being incorporated into an ornament depending on the intended use of the ring and the end result desired by the user.

Regarding claim 38, Pasfield discloses using preselected colors for the ring and the chart (see col. 2, lines 10-13, 30-32, 49-51 and 65-66). It is noted that the "whereby clause" set forth in the claim ("whereby one or more colors can indicate...in the second individual"), merely states the result of the limitations in the claim and adds nothing to the patentability or substance of the claim.

Regarding claims 39-41, the identification system of Pasfield uses various colors (which would, inherently, include yellow, red, green, blue, purple, pale blue, gray, white, orange and black) in the color section of the chart ("Colored flags or discs - see col. 2, lines 65-66). Pasfield discloses the claimed invention except for the specific arrangement and/or content of indicia (e.g., "the color yellow being associated with a keyword "available", the keyword "available" having a description to indicate that the wearer is not dating anyone seriously or is interested in meeting others") set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any required indicia for the chart, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art



in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of chart does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

### ***Response to Arguments***

3. Applicant's arguments filed May 3, 2004 have been fully considered but they are not persuasive.

#### **Response to Claim Rejections Under 35 U.S.C. § 103**

##### **A. Claim 22**

**Applicant argues that Pasfield fails to disclose, teach or suggest rings having colors that indicate social traits; symbols integrated on the rings that indicate to the individuals that the rings provide information on social traits about the other individual; charts having a keyword section that has a list of keywords succinctly describing a social characteristic and trait of an individual and a description section describing of the social characteristics and trait, as defined in claim 22.**

The examiner continues to maintain that the claimed intended use of the rings and symbols integrated on the rings does not provide a structural difference between

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the claimed invention and Pasfield. The intended use must result in a manipulative difference as compared to the prior art. In this case, the rings of Pasfield provide care information regarding the wearer of the rings to other individuals, such as doctors or nurses. There continues to be no difference between the claimed structure and the structure of Pasfield. Furthermore, the indicia integrated with the rings is not functionally related to the rings themselves and does not distinguish the invention from the prior art in terms of patentability. The rings of Pasfield are, therefore, capable of performing the intended use as claimed.

- i. Pasfield fails to disclose, teach or suggest a chart having a keyword section and description section.

**Applicant argues that the chart of Pasfield fails to disclose having a keyword section that succinctly describes a social characteristic and trait of an individual and a description section that describes the social characteristic and trait.**

The examiner disagrees and asserts that the particular information to be conveyed is not functionally related to the substrate (e.g., chart) upon which it is supported and does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information. Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner maintains that the color-coded chart of Pasfield is the same structure claimed by applicant and the sole difference is in the content of the printed

material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Furthermore, the chart of Pasfield contains a keyword and description section as seen in figure 3 (Keyword – “Pressure- Sore Sensitive” and Description – “(PATIENT REQUIRES FREQUENT TURNING OR MOVEMENT)”).

- ii. Pasfield fails to disclose, teach or suggest a ring having one or more colors that indicate a social characteristic or trait of an individual

**Applicant argues that the ring of Pasfield fails to disclose one or more colors that indicate a social characteristic or trait of an individual.**

The examiner continues to maintain that the claimed intended use of the colored rings and color-coded symbols integrated on the rings does not provide a structural difference between the claimed invention and Pasfield. The intended use must result in a manipulative difference as compared to the prior art. In this case, the rings of Pasfield provide care information regarding the wearer of the rings to other individuals, such as doctors or nurses. There continues to be no difference between the claimed structure and the structure of Pasfield. Furthermore, the indicia integrated with the rings is not functionally related to the rings themselves and does not distinguish the invention from the prior art in terms of patentability. The rings of Pasfield are, therefore, capable of performing the intended use as claimed.

- iii. Pasfield fails to disclose, teach or suggest a symbol integrated on a ring that indicates to the individuals that the rings provide information on social traits about the other individual

**Applicant argues that Pasfield fails to disclose any symbol that is integrated on a ring to indicate to the individuals that the rings are mounted on the individuals providing information of the individual's social interests, personality characteristics, or social traits about the other individual.**

The examiner continues to maintain that the claimed intended use of the rings and symbols integrated on the rings does not provide a structural difference between the claimed invention and Pasfield. The intended use must result in a manipulative difference as compared to the prior art. In this case, the rings of Pasfield provide care information regarding the wearer of the rings to other individuals, such as doctors or nurses. There continues to be no difference between the claimed structure and the structure of Pasfield. Furthermore, the indicia integrated with the rings is not functionally related to the rings themselves and does not distinguish the invention from the prior art in terms of patentability. The rings of Pasfield are, therefore, capable of performing the intended use as claimed.

- iv. Pasfield is not directed to a personal interest semaphore system for providing information related to social interests, personality characteristics, or social traits

In response to applicant's arguments, the recitation "a personal interest semaphore system for providing information related to social interests, personality characteristics, or social traits" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

B. Claim 31

**Applicant argues that Pasfield fails to disclose, teach or suggest the colors associated with the keywords and the keywords associated with the description.**

The examiner maintains that the chart of Pasfield (as seen in figure 3) discloses having a color section (colored flags or discs 10-13) associated with a keyword section and description section (the sections including a list of various conditions, such as, allergies, dietary requirements, etc. – see col. 2, lines 60-66 – Color –10 (Pink) is associated with Keyword – "Pressure- Sore Sensitive" and Description – "(PATIENT REQUIRES FREQUENT TURNING OR MOVEMENT)").

C. Claims 24, 28 and 30

**Applicant states that claims 24, 28 and 30 depend from claim 22 and, thus, are allowable for the same reasons as set forth above to claim 22.**

The examiner continues to disagree that claim 22 is allowable for the same line of reasoning as set forth above in section A. Therefore, claims 24, 28 and 30 are also found not be allowable for the same reasons as set forth above.

D. Claim 32

- i. Pasfield fails to disclose, teach or suggest providing a chart having a color section, keyword section, and description section

**Applicant argues that the chart of Pasfield fails to disclose having a keyword section that has a list of keywords that succinctly describes a social characteristic and trait of an individual and a description section that describes the social characteristic and trait.**

The examiner disagrees and asserts that the particular information to be conveyed is not functionally related to the substrate (e.g., chart) upon which it is supported and does not convey any meaningful information in regard to the substrate and does not require any particular substrate to effectively convey the information.

Thus, there is no meaningful functional relationship between the indicia and the substrate.

The examiner maintains that the color-coded chart of Pasfield is the same structure claimed by applicant and the sole difference is in the content of the printed material. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. Furthermore, the chart of Pasfield contains a keyword and description section as seen in figure 3 (Keyword – “Pressure- Sore Sensitive” and Description – “(PATIENT REQUIRES FREQUENT TURNING OR MOVEMENT)”).

E. Claims 39-41

**Applicant argues that Pasfield fails to teach, disclose or suggest the colors associated with the keywords and the keywords associated with the description of the keywords.**

The examiner maintains that the chart of Pasfield (as seen in figure 3) discloses having colors (colored flags or discs 10-13) associated with keywords and the keywords being associated with the description of the keywords (the sections including a list of various conditions, such as, allergies, dietary requirements, etc. – see col. 2, lines 60-66 – Color –10 (Pink) is associated with Keyword – “Pressure- Sore Sensitive” which is associated with Description – “(PATIENT REQUIRES FREQUENT TURNING OR MOVEMENT)”).

F. Claims 34 and 36

**Applicant states that claim 32 is allowable over the cited art of record and that dependent claims 34 and 36 are also allowable for the same reasons as set forth above to claim 32.**

The examiner continues to disagree that claim 32 is allowable for the same line of reasoning as set forth above in section D. Therefore, claims 34 and 36 are also found not be allowable for the same reasons as set forth above.

Conclusion

For the reasons as set forth above, the rejections are maintained.

***Conclusion***

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



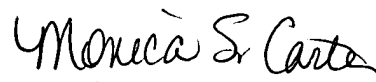
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (6:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 2, 2004

  
**MONICA S. CARTER**  
**PRIMARY EXAMINER**